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CENTRAL FAX CENTER Docket No. 10655.9400

REMARKS**JAN 04 2007**

Applicants reply to the Office Action mailed on September 12, 2006. The Examiner rejects claims 47-55 pending in the application. Applicants request reconsideration in view of the following remarks.

Applicants' counsel attempted to contact the Examiner to set an Examiner interview prior to replying to this Office Action. As such, Applicants counsel requests a formal **Examiner interview** prior to the Examiner issuing a Final Office Action, if the Examiner does not deem the following arguments sufficiently persuasive.

Additionally, Applicants note that, in the Examiner's comments, the Examiner paraphrased old claim language that no longer exists in the claims, so Applicants want to confirm that the Examiner has obtained and reviewed all previous amendments.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 47-55 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Israel *et al.*, U.S. Patent Application Publication No. US 2004/0210540 A1 ("Israel") in view of Atsmon *et al.*, U.S. Patent No. 6,607,136 ("Atsmon"). Applicants respectfully traverse this rejection.

As noted by the Examiner on Page 4 of the Office Action, Israel "fails to teach a system comprising a issuer dispute resolution form and an acquirer dispute resolution form to be selected by a user having issuer access right." Specifically, Israel does not disclose or teach at least "selecting, by said user **having said Issuer access right**, said **Issuer** dispute resolution form, a first form, wherein said **Issuer** dispute resolution form is independent of a type of said financial dispute, and said **Issuer** dispute resolution form is available to users with said **Issuer** access right," (emphasis added) as similarly recited in independent claims 47 and 51.

On Page 4 of the Office Action, the Examiner asserts that Atsmon "teach a system comprising a issuer dispute resolution form and an acquirer dispute resolution form to be selected by a user having issuer access right (see paragraphs 431, 542, 545)." As a preliminary matter, Applicants note that there are no paragraph numbers in the Atsmon issued patent, thus it is unclear as to which sections of Atsmon are referred to by the Examiner when the Examiner states "see paragraphs 431, 542, 545."

Atsmon teaches an interactive authentication system that allows a consumer to interact with a base station to receive coupons, special sales offers, and other information with an electronic card. The electronic card can be used to transmit a signal that can be received by the

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base station to perform tasks. The interaction between the base station and the electronic card is accomplished by using a conventional sound system.

Applicants have reviewed the Atsmon reference in detail. Atsmon does not disclose or teach at least "selecting, by said user **having said Issuer access right**, said Issuer dispute resolution form, a first form, wherein said Issuer dispute resolution form is independent of a type of said financial dispute, and said Issuer dispute resolution form is available to users with said Issuer access right," (emphasis added) as similarly recited in independent claims 47 and 51. Indeed, the only mention in Atsmon of any kind of dispute is in column 75, lines 22-41. Atsmon discloses that "a particular sales transaction can be disputed by the customer" and "to resolve the dispute, the customer 314 can call the issuer bank 313." **Practitioners will appreciate that Atsmon discloses the very well-known practice of simply calling the merchant or bank to resolve a dispute, without any mention of forms, issuers, acquirers or access rights.**

Applicants assert that neither Israel, Atsmon, nor any combination thereof, disclose or teach "selecting, by said user **having said Issuer access right**, said Issuer dispute resolution form, a first form, wherein said Issuer dispute resolution form is independent of a type of said financial dispute, and said Issuer dispute resolution form is available to users with said Issuer access right," (emphasis added) as similar recited by independent claims 47 and 51.

Furthermore, Israel and Atsmon do not contains any suggestion or motivation to make the proposed combination. Israel teaches a system that enables adverse parties to conduct and manage a non-judicial dispute resolution. Atsmon teaches an interactive authentication system that allows a consumer to interact with a base station to receive coupons, special sales offers, and other information with an electronic card. There is no suggestion or motivation in Israel or Atsmon to combine the non-judicial dispute resolution system of Israel with the interactive authentication system of Atsmon. As stated in MPEP 2142, "the examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. **If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.**" (emphasis added) In order to establish a *prima facie* case of obviousness, "there must be some suggestion, teaching or motivation to modify the reference or combine the references on which the rejection is based." MPEP 2142. It is well established that "[t]he presence or absence of a motivation to combine references in an obviousness determination is a pure question of fact." *In re Gariside*, 203 F.3d 1305, 1316, 53 USPQ2d 1769, 1776 (Fed. Cir. 2000). Accordingly, Office Actions rejecting claims for obviousness **must be supported by**

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evidence. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight. *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999); emphasis added.

Moreover, the evidence on which an obviousness rejection is based must be set forth in the Office Action. As stated in MPEP 2144.08 III, "Explicit findings on motivation or suggestion to select the claimed invention should also be articulated in order to support a 35 U.S.C. 103 ground of rejection.... Conclusory statements of similarity or motivation, without any articulated rationale or evidentiary support, do not constitute sufficient factual findings."

For the above reasons, Applicants submit that the invention of claims 47 and 51 would not have been obvious over Israel in view of Atsmon, and therefore claims 47 and 51 are allowable. Accordingly, Applicants respectfully request the withdrawal of the rejection of claims 47 and 51 under 35 U.S.C. § 103(a).

Dependent claims 48-50 and 52-55 variously depend from independent claims 47 and 51, so dependent claims 48-50 and 52-55 are differentiated from the cited reference for at least the same reasons as set forth above, as well as in view of their own respective features.

CONCLUSION

In view of the foregoing, Applicants respectfully submit that all of the pending claims, namely 47-55, fully comply with 35 U.S.C. §112 and are allowable over the art of record. Reconsideration of the application is respectfully requested. Should the Examiner wish to discuss any of the above in greater detail or deem that further amendments should be made to improve the form of the claims, then the Examiner is invited to contact the undersigned at the Examiner's convenience. Applicants authorize and respectfully request that any fees due be charged to Deposit Account No. 19-2814, including any required extension fees.

Respectfully submitted,

Date:

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By:

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